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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,631	03/14/2001	Elaine Scott Mason	COS99041	3005
25537	7590	05/09/2006	EXAMINER	
VERIZON PATENT MANAGEMENT GROUP 1514 N. COURTHOUSE ROAD SUITE 500 ARLINGTON, VA 22201-2909			LIVERSEDGE, JENNIFER L	
		ART UNIT	PAPER NUMBER	
			3628	
DATE MAILED: 05/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/805,631	MASON, ELAINE SCOTT	
	Examiner	Art Unit	
	Jennifer Liversedge	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 March 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-37 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-37 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/805,631 filed on March 8, 2006.

The amendment contains amended claims: 1, 8, 9, 15, 16, 22, 29 and 36.

The amendment contains original claims: 2-7, 10-14, 17-21, 23-28, 30-35 and 37.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 8-11, 15-18, 22-25, 29-32 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,289,322 B1 to Kitchen et al. (further referred to as Kitchen), and further in view of U.S. Patent Publication No. 2001/0037297 A1 to McNair (further referred to as McNair).

Regarding claims 1 and 22, Kitchen discloses a method and server apparatus for providing an on-line billing system (column 3, lines 6-8; column 5, line 66 – column 6, line 7) the method and server comprising retrieving invoice information corresponding to a customer (column 3, lines 9-15; column 6, lines 29-52); displaying the invoice amount via a web browser (column 4, lines 37-42; column 8, lines 4-8); receiving an input to initiate payment corresponding to the invoice amount (column 8, line 63-column 9, line 8; column 12, lines 16-48);

Kitchen does not disclose determining whether the invoice amount is a zero balance or a credit balance and selectively terminating the payment and generating a disallow payment message based upon the determining step. However, McNair discloses determining whether the invoice amount is a zero balance or a credit balance (Figure 1 and Figure 2; page 3, paragraph 0048) and selectively terminating the payment and generating a disallow payment message based upon the determining step (Figure 4; page 4, paragraph 0055 and 0056).

It would be obvious to one of ordinary skill in the art to combine determining the balance and selectively terminating the payment as disclosed by McNair with the on-line

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billing system as disclosed by Kitchen. The motivation would be to prevent the accounting issues associated with carrying a credit associated with a customer account.

Regarding claim 2, 9, 16, 23 and 30, Kitchen does not disclose the method, server apparatus, system or computer-readable medium wherein the determination step comprises applying business rules in real-time. However, McNair discloses wherein the determination step comprises applying business rules in real-time (page 4, paragraphs 0055 and 0056). It would be obvious to combine making a determination using business rules in real time as disclosed by McNair with the on-line billing system as disclosed by Kitchen. The motivation would be to prevent a credit from being applied to a customer's account while the customer was on-line and such a credit could be prevented via terminating the payment.

Regarding claims 3, 10, 17, 24 and 31, Kitchen discloses the method, server apparatus, system and computer-readable medium for loading the invoice information into an interim data store (column 6, lines 24-49); and parsing the invoice information for loading into a database (column 6, lines 50-58).

Regarding claim 4, 11, 18, 25 and 32, Kitchen discloses the method, server apparatus, system and computer-readable medium for performing a splitter process to parse the invoice information for account number information and invoice amount associated with the customer, wherein a working file is selectively generated based

upon comparison of the invoice information with data that is stored in a data store containing enrollment information (column 4, lines 42-55; column 6, lines 29-49); and performing an extract process to parse the generated working file based upon a predefined extract definition (column 3, lines 9-32; column 6, lines 50-58).

Regarding claim 8, Kitchen discloses a server apparatus for providing an on-line billing system (column 3, lines 6-8; column 5, line 66 – column 6, line 7) the server apparatus comprising a communication interface configured to retrieve invoice information corresponding to a customer (column 3, lines 9-15; column 6, lines 29-52); and a processor coupled to the communication interface and configured to instruct display of the invoice amount via a web browser (column 4, lines 37-42; column 8, lines 4-8); wherein the communication interface receives an input to initiate payment corresponding to the invoice amount (column 8, line 63-column 9, line 8; column 12, lines 16-48);

Kitchen does not disclose the processor determining whether the invoice amount is a zero balance or a credit balance and selectively terminating the payment and generating a disallow payment message based upon the determination. However, McNair discloses determining whether the invoice amount is at least one of a zero balance and a credit balance (Figure 1 and Figure 2; page 3, paragraph 0048) and selectively terminating the payment and generating a disallow payment message based upon the determining step (Figure 4; page 4, paragraph 0055 and 0056).

It would be obvious to one of ordinary skill in the art to combine determining the balance and selectively terminating the payment as disclosed by McNair with the on-line billing system as disclosed by Kitchen. The motivation would be to prevent the accounting issues associated with carrying a credit associated with a customer account.

Regarding claim 15, Kitchen discloses an e-billing system (column 3, lines 6-8; column 5, line 66 – column 6, line 7) comprising a database configured to store information corresponding to a customer (column 6, lines 29-50); a server communicating with the database, the server being configured to retrieve the invoice information from the database (column 3, lines 9-15; column 6, lines 29-52); the server being configured to instruct display of the invoice amount via a web browser (column 4, lines 37-42; column 8, lines 4-8); and a client communicating with the server, the client being configured to run the web browser and to transmit to the server to initiate payment corresponding to the invoice amount (column 8, line 63-column 9, line 8; column 12, lines 16-48);

Kitchen does not disclose the server determining whether the invoice amount is a zero balance or a credit balance and selectively terminating the payment and generating a disallow payment message based upon the determination. However, McNair discloses the server determining whether the invoice amount is a zero balance or a credit balance (Figure 1 and Figure 2; page 3, paragraph 0048) and selectively terminating the payment and generating a disallow payment message based upon the determination (Figure 4; page 4, paragraph 0055 and 0056).

It would be obvious to one of ordinary skill in the art to combine determining the balance and selectively terminating the payment as disclosed by McNair with the on-line billing system as disclosed by Kitchen. The motivation would be to prevent the accounting issues associated with carrying a credit associated with a customer account.

Regarding claim 29, Kitchen discloses a computer-readable medium carrying one or more sequences of one or more instructions for providing an on-line billing system, the one or more sequences of one or more instructions including instructions which, when executed by one or more processors, cause the or more processors to perform the steps of retrieving invoice information corresponding to a customer (column 3, lines 9-15; column 6, lines 29-52); displaying the invoice amount via a web browser (column 4, lines 37-42; column 8, lines 4-8); receiving an input to initiate payment corresponding to the invoice amount (column 8, line 63-column 9, line 8; column 12, lines 16-48);

Kitchen does not disclose determining whether the invoice amount is a zero balance or a credit balance and selectively terminating the payment and generating a disallow payment message based upon the determining step. However, McNair discloses determining whether the invoice amount is a zero balance or a credit balance (Figure 1 and Figure 2; page 3, paragraph 0048) and selectively terminating the payment and generating a disallow payment message based upon the determining step (Figure 4; page 4, paragraph 0055 and 0056).

It would be obvious to one of ordinary skill in the art to combine determining the balance and selectively terminating the payment as disclosed by McNair with the on-line billing system as disclosed by Kitchen. The motivation would be to prevent the accounting issues associated with carrying a credit associated with a customer account.

Regarding claim 36, Kitchen does not disclose a payment disallow mechanism, a mechanism for determining whether the total invoice amount is a zero balance or credit balance prior to executing the electronic payment, wherein response to determination of the zero or credit balance, the mechanism terminating the payment mechanism and generating a disallow payment message for display to the customer.

However, McNair discloses a payment disallow mechanism, a mechanism for determining whether the total invoice amount is a zero balance or credit balance prior to executing the electronic payment (Figure 1 and Figure 2; page 3, paragraph 0048), wherein response to determination of the zero or credit balance, the mechanism terminating the payment mechanism and generating a disallow payment message for display to the customer (Figure 4; page 4, paragraph 0055 and 0056).

It would be obvious to one of ordinary skill in the art to combine determining the balance and selectively terminating the payment as disclosed by McNair with the on-line billing system as disclosed by Kitchen. The motivation would be to prevent the accounting issues associated with carrying a credit associated with a customer account.

Kitchen discloses an e-billing system including a computer system accessible for on-line interactive communication of invoices to users (column 3, lines 6-8; column 5,

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line 66 – column 6, line 7), computer system comprising a database for storing customer invoice information (column 3, lines 9-15; column 6, lines 29-52), the information including an invoice date and a total invoice amount (Figure 9A and Figure 11), the invoice information displayed to the customer for on-line interaction (column 4, lines 37-42; column 8, lines 4-8);

A mechanism for initiating electronic payment of the modified total invoice amount via the e-billing system (column 8, line 63-column 9, line 8; column 12, lines 16-48).

Regarding claim 37, Kitchen discloses the wherein the mechanism for determining the total invoice amount implemented in a web server providing the on-line interactive communication (column 3, lines 6-15; column 5, line 66 – column 6, line 7).

Claims 5, 12, 19, 26 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen and McNair as applied to claims 1, 8, 15, 22 and 29 above, and further in view of "Pay and Save" in Accountancy, June 1999 (further referred to as Pay and Save). Neither Kitchen nor McNair disclose the method, server apparatus, system and computer-readable medium for calculating a discount for early payment of an invoice amount associated with the invoice information; and selectively applying the discount based discount business rule. However, Pay and Save discloses calculating a discount for early payment of an invoice amount associated with the invoice information; and selectively applying the discount based discount business rule (page 2, lines 4-20).

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It would be obvious to one of ordinary skill in the art to combine providing a discount for early payment as disclosed by Pay and Save with the on-line billing system as disclosed by Kitchen and McNair. The motivation would be to motivate customers to pay earlier, thus making cash available earlier.

Claims 6, 13, 20, 27 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen and McNair as applied to claims 1, 8, 15, 22 and 29 above, and further in view of "E-forms Learn New Language" by H. Hayes, February 21, 2000 (further referred to as E-forms). Kitchen discloses generating an invoice page containing the invoice information (column 6, line 59 – column 7, line 12). Neither Kitchen nor McNair disclose the method, server apparatus, system and computer-readable medium for generating an HTML invoice. However, E-forms discloses generating an HTML invoice (page 1, lines 13-17 and page 2, lines 1-3). It would be obvious to one of ordinary skill in the art to use HTML as disclosed by E-forms with the on-line billing system as disclosed by Kitchen and McNair. The motivation would be to use the most common language for Internet web page design for efficient and economical web page development.

Claims 7, 14, 21, 28 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen, McNair and E-forms as applied to claims 6, 13, 20, 27 and 34 above, and further in view of U.S. Patent No. 5,870,473 to Boesch et al. (further referred to as Boesch).

Kitchen does not disclose the method, server apparatus, system and computer-readable medium for auditing the HTML invoice page to determine whether a billing error exists, and regenerating the HTML page invoice page to correct the billing error. However, McNair discloses auditing the invoice page to determine whether a billing error exists, and regenerating the page invoice page to correct the billing error (page 4, paragraphs 0055 and 0056). The combination for HTML forms was developed in claim 6. It would be obvious to one of ordinary skill in the art to combine auditing and regenerating the invoice page when errors are found as disclosed by McNair with the on-line billing system as disclosed by Kitchen. The motivation would be to correct any billing errors for proper and accurate billing.

Neither Kitchen, McNair nor E-forms disclose generating a severity code associated with the billing error. However, Boesch discloses generating a severity code associated with the billing error (column 23, lines 36-41; column 24, lines 46-51; column 25, lines 12-17; column 26, lines 4-9, column 35, lines 5-22). It would be obvious to one of ordinary skill in the art to combine generating a severity code as disclosed by Boesch with the on-line billing system as disclosed by Kitchen, McNair and E-forms. The motivation would be to collect quantitative data related to errors for tracking and data compilation.

Response to Arguments

Applicant's arguments filed March 8, 2006 have been fully considered but they are not persuasive.

The two primary arguments set forth in the current amendment regarding the Office Action mailed December 7, 2005 relate to determining whether the invoice amount is a zero balance or a credit balance and generating a disallow payment message (page 15).

Regarding the determination of whether the invoice amount is a zero balance or a credit balance, the Examiner cited McNair, particularly Figures 1 and 2 and page 4, paragraphs 55 and 56. The Applicant argues these passages cited do not speak to the determination of whether the invoice amount is a zero balance or a credit balance. However, the Examiner points out that on page 4, paragraph 55 McNair discloses where a range of payment is allowed for, based on determination of the account balance. Figures 1 and 2 show how a balance is determined, which is an old and well known technique in the art for determining a balance. On page 4, paragraph 55, McNair sets forth the mechanism by which this balance is communicated to the account owner, and then the responses which are allowed by the account owner in making a payment. McNair discloses where the account owner may select from either a) a minimum payment, b) an intermediate payment, or c) a payment of the full account balance. McNair offers only these three methods of payment amount selection. The account owner may NOT select an amount which is less than the minimum payment and the account owner may NOT select an amount which is greater than the full account balance.

McNair accounts for an errors related to payment amount selection on page 4, paragraph 56. If any input error is received, then an error message is sent to the

account owner. If the account owner selects an amount below the minimum due or above the full account balance, an error message is sent and the payment is disallowed. While McNair's disclosed message may not specifically use the words "payment disallowed", McNair is sending an error message regarding an improper payment attempt and the payment is disallowed. It would be obvious to one of ordinary skill in the art that any text can be generated and viewed regarding an error, or a success for that matter, regarding interactions with computer networks.

The method as disclosed by McNair determines an account balance as is well known in the art, and then establishes limits and boundaries for which an account holder may select payment options. McNair does not allow for a payment below a minimum to be accepted and McNair does not allow for a payment above a full account balance to be accepted. If the full account balance is not at least of some financial value, then no payment would be allowed. If the full account balance was \$1,187.46, then not more than \$1,187.46 would be allowed (McNair example, page 4). If the balance determined based on techniques old and well known as shown in Figures 1 and 2 resulted in a balance of \$52.13, then not more than \$52.13 would be accepted. And if the balance determined based on techniques old and well known as shown in Figures 1 and 2 resulted in a balance of \$0, then not more than \$0 would be accepted. Similarly, if the balance determined based on techniques old and well known as shown in Figures 1 and 2 resulted in a credit balance of \$52.13, then nothing would be accepted because there is no balance due.

Minor arguments are made with regard to the use of applying business rules in real time (page 16). The Examiner cited page 4, paragraphs 55-56 and the Applicant finds no discussion of business rules in this passage. The Examiner argues that making decisions on user inputs and the responses that should follow as a result, this transaction occurring in real time, does represent a business decision being made in real time. Displaying an account page with an appropriately determined balance based on account information, determining whether or not to accept an account owner's offer of payment, determining what type of message to send in response to the received offer of payment are all seen as business decisions occurring in real time.

Applicant argues Pay and Save as being applied for "supposed teaching of calculating a discount for early payment of an invoice". Examiner advises Applicant to review current (and previous) Office Action where Pay and Save in fact shows offering businesses discounts for making payments early.

Applicant argues the use of E-forms for a "supposed disclosure of generating an HTML invoice". Examiner advises Applicant to review current (and previous) Office Action where E-forms in fact shows the use of HTML in generating invoices.

Applicant argues the use of Boesch et al. for "supposed teaching of generating a severity code associated with the billing error". Examiner advises Applicant to review current (and previous) Office Action where Boesch et al. in fact shows the use severity codes for billing concerns.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached at 571-272-6799. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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